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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,017	05/31/2007	David C. Windorski	59529US005	1997

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EXAMINER

SHAH, SAMIR

ART UNIT	PAPER NUMBER
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1787

NOTIFICATION DATE	DELIVERY MODE
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04/28/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/587,017	Applicant(s) WINDORSKI ET AL.	
	Examiner SAMIR SHAH	Art Unit 1787	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42,46,52,53,56-60,63-65 and 68-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42,46,52,53,56-60,63-65 and 68-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20101223</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Upon consideration of the amendment filed on February 14, 2011, the following action is set forth. In light of the new grounds of rejection set forth below with respect to previous claim 62 (which limitations are now included in claim 1), the following action is non-final.

NOTE: In order to cancel text from claims, applicants are advised to show cancelled text by strike-through line since brackets do not indicate cancellation of text. Double brackets can be used to indicate cancellation of text, but must be used only to show deletion of five or fewer consecutive characters or if strikethrough cannot be easily perceived (see MPEP 714). It is noted, however, for examination purposes that any text in brackets in the present claims is considered by the examiner to be cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 52 recites the limitation "the standoff element" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 42, 46, 53, 63-65, 68-69** are rejected under 35 U.S.C. 102(b) as being anticipated by Holmberg et al. (US 4447481).

7. Regarding claim 42, Holmberg discloses a paper sheet, i.e. an index card, (title) for printing, i.e. writeable surface (column 1, lines 23-25) and a mounting surface on a opposite side thereof (column 1, lines 27-40). The paper sheet of Holmberg has a recess formed (12, figure 3, column 1, lines 63-65) on a side of the substrate (10, figure 3, column 1, line 63) and repositionable pressure sensitive adhesive disposed only within the recess (14a, figure 7, column 2, lines 33-35 and line 55), the recess having a depth, relative to an unrecessed portion of the second side of the first substrate (see figures 3 and 7) and the first side of the substrate having no surface discontinuities. Given that the combined thickness of adhesive and protective strip, i.e. securing mechanism, is no greater than the depth of recess (column 1, line 67 to column 2, line 1), it is clear that there is sufficient to space the adhesive from the mounting substrate in the absence of the application of the threshold level of pressure wherein in the absence of a threshold level of pressure applied on the first side of the first substrate to the securing mechanism, the pressure sensitive adhesive is spaced from the mounting

Art Unit: 1787

substrate, and wherein the sheet is deformable such that a threshold level of pressure applied to the first side of the first substrate on the securing mechanism brings the pressure sensitive adhesive into sheet securing engagement with the mounting substrate.

8. Regarding claim 46, Holmberg discloses the same paper sheet, i.e. index card, as disclosed in present claim, it is clear that upon removal of the sheet from the mounting substrate, the securing mechanism substantially returns to its original undeformed shape.

9. Regarding claim 53, given that the combined thickness of the adhesive and protective strip is no greater than the depth of the recess (column 1, line 67 to column 2, line 1), it is clear that a plurality of cards aligned in a stacked orientation would inherently fail to adhere together, absent the application of pressure to the outer faces of their respective cover layers.

10. Regarding claim 63, Holmberg discloses paper sheet wherein the first substrate has upper edge and wherein the recess has an upper border which extends along and is spaced from the upper edge of the first substrate (see figure 5).

11. Regarding claim 64, Holmberg discloses paper sheet wherein the first substrate has first and second side edges, and wherein the recess extends across the first substrate from first side edge to the second side edge thereof (see figure 6).

12. Regarding claim 65, Holmberg discloses paper sheet wherein the exposed pressure sensitive adhesive has an edge on the second side of the first substrate (figure 3), and wherein the security mechanism comprises a spacer layer (10, figure 3) of

Art Unit: 1787

material on the second side of the first substrate adjacent the edge of the exposed pressure sensitive adhesive (the area of figure 3 where there is no recess and its thicker than the recess), the spacer layer having a shape relative to the adhesive and having a height of the adhesive, said shape and height of the spacer layer being sufficient to space the adhesive from the mounting substrate in the absence of the application of the threshold level of pressure (see figure 7).

13. Regarding claims 68 and 69, given that the paper sheets are stacked (column 1, lines 25-26) and the combined thickness of the adhesive and protective strip is no greater than the depth of the recess (column 1, line 67 to column 2, line 1), it is clear that when a stack of comprising two or more index cards are arranged top to bottom, cards do not stick to one another and cards can be shuffled without adhering to other cards.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claim 70** is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg et al. (US 4447481).

Art Unit: 1787

16. Regarding claim 70, Holmberg does not disclose a plurality of ruled lines on the surface of paper. However, the court found that matters relating to ornamentation only, such as ruled lines, which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965). Therefore, it would have been obvious to one of ordinary skill in the art to modify the sheet of Holmberg with any ornamentation, including lines, depending on the desired design and end use.

17. **Claims 56-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg et al. (US 4447481) in view of Sommers (U.S. 5924227).

18. Holmberg discloses pressure sensitive adhesive sheet as described above. Regarding claims 56-58, Holmberg fails to meet the limitation of present claims.

19. Sommers discloses an index card wherein a score line on the substrate which is placed from and parallel to the upper edge of the substrate and a cut formed through the substrate, the cut extending from a first end on the score line toward the upper edge to a first turn, extending from the first turn along and spaced from the upper to a second turn, and then extending from the second turn away from the upper edge to a second end of the cut on the score line (figures 2 and 3).

20. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the folding mechanism of Sommers with the sheet structure of Holmberg so that it is easy to view and handle.

Art Unit: 1787

21. Regarding claims 59-60, Holmberg discloses pressure sensitive adhesive sheet wherein it comprises pressure sensitive adhesive (column 1. lines 35-36). Holmberg alone fails to meet all the limitation as present claims.

22. Sommers discloses an index card wherein the spacing portion of the substrate being folded over so that it lean towards the second side of the substrate, thereby forming a raised layer on the second side of the substrate which defines the standoff element and which has a higher thickness than the substrate (figures 2 and 3).

23. It would have been obvious to one of ordinary skill in the art at the time of the invention to put pressure sensitive adhesive of Holmberg on the folded portion to have better adhesion than just folding.

Response to Arguments

24. Applicant's arguments with respect to claims 42, 46, 52-53, 56-60, 63-65 and 68-70 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMIR SHAH whose telephone number is (571)270-1143. The examiner can normally be reached on 8am to 5pm.

Art Unit: 1787

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAMIR SHAH/
Examiner, Art Unit 1787

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787